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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,282	07/07/2003	David B. MacLean	PC9517H	8230
28523	7590	05/18/2007	EXAMINER	
PFIZER INC. PATENT DEPARTMENT, MS8260-1611 EASTERN POINT ROAD GROTON, CT 06340			SPIVACK, PHYLLIS G	
		ART UNIT	PAPER NUMBER	
		1614		
		MAIL DATE	DELIVERY MODE	
		05/18/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/615,282	Applicant(s) MACLEAN ET AL.
	Examiner Phyllis G. Spivack	Art Unit 1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 4-13-07.  
2a)  This action is **FINAL**.                  2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 23-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 23-26 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
    1.  Certified copies of the priority documents have been received.  
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## **Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_.  
  

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Applicants' Response filed April 13, 2007 is acknowledged. Claims 23-26 remain under consideration.

The indication of finality set forth in the last Office Action is withdrawn.

A new title of the invention is noted.

A new abstract of the disclosure is further noted.

In the last Office Action claims 23-26 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed, had possession of the claimed invention. This is a Written Description rejection. It was asserted Applicants have not described any therapeutic regimens in which any compound of the present invention is administered to inhibit inflammatory bowel disease.

In response, Applicants cite various parts of the instant specification and urge compliance to the written description requirement. Specifically, on page 3, line 5 through page 7, line 28, a mere statement drawn to inhibiting inflammatory bowel disease is noted. However, according to *Genentech Inc. vs. Nova Nordisk*, "[A] patent is not a hunting license. It is not a reward for a search but a compensation for its successful conclusion and 'patent protection' is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable." (42 USPQ 2d 101, Fed. Circuit 1997). Page 26, line 20 through page 33, line 30, depict a general synthesis of the claimed compounds; page 38, line 22 through page 39, line 8, depict methods of determining estrogenic and/or anti-estrogenic potential; page 39, lines 9-28, depict an estrogen receptor binding assay; page 34, lines 1-26, depict administration of the claimed compounds for any purpose; page 34, line 27 through page 38, line 21, describe dosages and dosage regimens.

Because the disclosure does not provide an adequate written description for the claimed genus of compounds in methods of inhibiting inflammatory bowel disease that would indicate Applicants were actually in possession of the claimed methods at the time the invention was made, the rejection of record of claims 23-26 under 35 U.S.C. 112, first paragraph, is maintained for the reasons of record.

The elected species compound (-)-cis-6-phenyl-5-[4-(2-pyrrolidin-1-yl)-ethoxy)-phenyl]-5,6,7,8-tetrahydro-naphthalen-2-ol is free of the prior art.

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this Final Action is set to expire THREE MONTHS from the mailing date of this Action. In the event a first reply is filed within TWO MONTHS of the mailing date of this Final Action and the Advisory Action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the Advisory Action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the Advisory Action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this Final Action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Phyllis G. Spivack whose telephone number is 571-272-0585. The Examiner can normally be reached from 10:30 to 7 PM.

If attempts to reach the Examiner by telephone are unsuccessful after one business day, the Examiner's supervisor, Ardin Marschel, can be reached 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 15, 2007

  
Phyllis Spivack  
1614                    PHYLIS SPIVACK  
                          PRIMARY EXAMINER